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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,542	02/10/2000	Bruce L Davis	60109	5321
23735 7590 12/02/2008 DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
12/02/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/502,542

**Applicant(s)**

DAVIS ET AL.

**Examiner**

MARK FADOK

**Art Unit**

3625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-7, 9, 12, 13, 19, 21, 26, 27, 31 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) 3-6, 9, 12-19 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 21, 26, 31, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



***Response to Amendment***

The examiner is in receipt of applicant's response to office action mailed 4/21/2008, which was received 8/1/2008. Acknowledgement is made to the amendment to claims 21,26,31, withdrawal of claims 9,12-19,27, cancellation of claims 8,10,11,20,22-25,28-30,32 and the addition of claims 33-36. Applicant's amendment and remarks have been carefully considered, but were not found to be persuasive; therefore, the previous action is restated below modified as necessitated by amendment.

***Election/Restrictions***

Newly submitted claims 35 and 36 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new invention requires additional search and consideration for the features of creating a hybrid store that presents a user a single online experience from which products may be purchased and shipped.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 35 and 36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Examiner's Note***

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case the meaning of the phrase "...as if the purchases were made online" is not clear and is further not defined in the specification".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Swartz (US 6,243,447) in view of St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.**

#### **First rejections of claims 33 and 34**

In regards to claim 33 Swartz discloses a method comprising: in connection with a user's expression of interest in a first item available for sale from a first vendor, adding information associated therewith to a data structure associated with the user; and recalling data from said data structure in connection with presenting to the user information about one or more items offered for sale by a second vendor; wherein the first and second vendors are different (See Board of appeals response to previous rejection Appeal # 2007-0065 dated 8/22/2007 pages 3-9, 37and 38).

In regards to claim 34, Swartz method comprising: in connection with a user's expression of interest in a first item available for sale from a first vendor, adding information associated therewith to a data structure associated with the user; in connection with a user's expression of interest in a second item available for sale from a second vendor different than the first vendor, adding information associated

therewith to said data structure; and in a subsequent on-line shopping session by said user, populating a presentation of merchandise offerings that is displayed to the user in accordance with information from said data structure (See Board of appeals response to previous rejection Appeal # 2007-0065 dated 8/22/2007 pages 3-9, 37 and 38).

**Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cybul (US 6,246,997) and further in view of Loeb et al (US 6,360,209).**

**In regards to claim 31**, Cybul discloses a method comprising:

providing a mall storefront that displays certain items offered for sale, but does not stock an inventory from which sales of these items can be fulfilled (col 4, lines 48-67);

providing a sensor device to a customer (col 3, line 40-col 4, line 30); and

allowing the customer to handle the displayed products and sense machine readable data from products of interest to the customer, generating an electronic list (col 5, lines 1-45).

Cybul teaches sensing product codes and transferring that information electronically to a fulfillment warehouse (supra), but does not specifically mention wherein the method includes fulfilling said purchases as if the purchases were made

online, by passing said list to a third party fulfiller different than a provider of the mall storefront. Loeb teaches using a third party fulfiller to fill orders from a sales merchant and later shipping the product to the customer (FIG 1) item 60, third party fulfillment house). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Cybul the use of a third party fulfiller as is taught by Loeb, because the merchant will only need to carry the inventory that is present on the store shelves and will therefore not incur the costs of maintaining an inventory of items thus requiring less overhead and management which will save money for the retailer.

**Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cybul (US 6,246,997) and further in view of Walter et al (US 6,334,110).**

**In regards to claim 34**, Cybul teaches in a subsequent on-line shopping session by said user, populating a presentation of merchandise offerings that is displayed to the user in accordance with information from said data structure (Summary) but does not specifically mention that the data is populated from multiple vendors. Walter teaches collecting shopping data from a plurality of stores both on line and Brick and mortar (Walter, FIG 4). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Cybul collecting data from a plurality of vendors and saving that information in Cybul's list builder (FIG 1, item 14), because collecting information from a plurality of vendors provides a more complete list (Walter, Summary).



**Claim 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trotta Jr. in view of Cybul et al (US 6,246,997) in view of Official Notice.**

**In regards to claim 7**, the combination of Trotta Jr. and Cybul discloses a method comprising:

**In regards to claim 21**, the combination of Trotta Jr. and Cybul discloses a method of facilitating on-line shopping comprising:

collecting data about products of interest during a shopper's visit to a bricks and mortar store (Trotta, abstract);

Trotta teaches collecting information about a shopping experience, but does not specifically mention "said user later signing-on to an on-line store or virtual storefront over the internet, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer". Cybul teaches accessing an on-line store or virtual storefront over the internet, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer (Cybul abstract). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Trotta from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer as is taught by Cybul (FIG 1, List builder tool), because magnitudes make the first time shopping experience overwhelming (Cybul; col 1, lines 20-30)

The combination of Trotta and Cybul teaches through use of a user interface of the user's computer, receiving input from the user identifying a subset of items from said customized selection of items, in connection with a purchase transaction of said subset of items from the on-line store or virtual, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer storefront, but does not specifically mention that the customer signs-on. The examiner takes Official Notice that signing-on to a system was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Trotta and Cybul signing-on to access the information, because this provides a proven method for identifying the individual that will permit the system to pull up the information pertinent to the user.

using the collected data in said shopper's online shopping session with the online store or virtual storefront (Cybul, col 1, line 60 to col 2, line 4);

wherein at least certain of the products of potential interest are not purchased by said shopper during said visit to said store (Trotta, FIG 2).

logging the shopper's habits or preferences exhibited in the on-line store or virtual storefront, in one or more database records associated with that shopper (Cybul, FIG 1, item 28); and

Cybul teaches using information from both an online shopping experience and a physical store and Trotta teaches using information stored to provide information to the

shopper in a brick and mortars store. It would have been obvious to include in Trotta the information that was available through Cybul, because this will provide more focused advertising to entice the user to buy more product (Trotta, col 7, line 3-20)

**In regards to claim 21**, the combination of Trotta Jr. and Cybul discloses a method of facilitating on-line shopping comprising:

collecting data about products of interest during a shopper's visit to a bricks and mortar store (Trotta, abstract);

Trotta teaches collecting information about a shopping experience, but does not specifically mention "said user later signing-on to an on-line store or virtual storefront over the internet, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer". Cybul teaches accessing an on-line store or virtual storefront over the internet, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer (Cybul abstract). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Trotta from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer as is taught by Cybul (FIG 1, List builder tool), because magnitudes make the first time shopping experience overwhelming (Cybul; col 1, lines 20-30)

The combination of Trotta and Cybul teaches through use of a user interface of the user's computer, receiving input from the user identifying a subset of items from said customized selection of items, in connection with a purchase transaction of said subset of items from the on-line store or virtual, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer storefront, but does not specifically mention that the customer signs-on. The examiner takes Official Notice that signing-on to a system was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Trotta and Cybul signing-on to access the information, because this provides a proven method for identifying the individual that will permit the system to pull up the information pertinent to the user.

using the collected data in said shopper's online shopping session with the online store or virtual storefront (Cybul, col 1, line 60 to col 2, line 4);

wherein at least certain of the products of potential interest are not purchased by said shopper during said visit to said store (Trotta, FIG 2).

### **Second rejection of claim 33**

**In regards to claim 33** the combination Trotta and Cybul disclose a method comprising: in connection with a user's expression of interest in a first item available for sale from a first vendor, adding information associated therewith to a data structure associated with the user; and

recalling data from said data structure in connection with presenting to the user information about one or more items offered for sale by a second vendor; wherein the first and second vendors are different (see response to claim 26).

**Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trotta Jr. in view of Cybul et al (US 6,246,997) in view of Official Notice and further in view of Deaton (US 6,993,498)**

**In regards to claim 26**, Trotta Jr. discloses a method comprising:

sensing indicia from selected items offered for sale in a bricks and mortar store, and compiling a list therefrom (Trotta, FIG 2);

storing said list in a data structure associated with a user (col 1, lines 47-63);

Trotta teaches collecting information about a shopping experience, but does not specifically mention "said user later signing-on to an on-line store or virtual storefront over the internet, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer". Cybul teaches accessing an on-line store or virtual storefront over the internet, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer (Cybul abstract). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Trotta from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized

selection of items on a display of the user's computer as is taught by Cybul (FIG 1, List builder tool), because magnitudes make the first time shopping experience overwhelming (Cybul; col 1, lines 20-30)

The combination of Trotta and Cybul teaches through use of a user interface of the user's computer, receiving input from the user identifying a subset of items from said customized selection of items, in connection with a purchase transaction of said subset of items from the on-line store or virtual, from a user's computer and said on-line store or virtual storefront using said list to present to said user a customized selection of items on a display of the user's computer storefront, but does not specifically mention that the customer signs-on. The examiner takes Official Notice that signing-on to a system was old and well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Trotta and Cybul signing-on to access the information, because this provides a proven method for identifying the individual that will permit the system to pull up the information pertinent to the user.

wherein the sensing of item indicia in the bricks and mortar store facilitates user shopping in an on-line store or virtual storefront, by enabling customization of the selection of items presented to the user by said online store or virtual storefront ( Cybul, FIG 1).

the combination of Trotta Jr. and Cybul teaches gathering information to facilitate a later transaction, but does not specifically teach "the recalled list is used by a second vendor different from the first, to present a customized selection of items in an on-line

store or virtual storefront. Deaton teaches utilizing a shopping list to effect a later transaction (col 2, lines 25-35). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Trotta and Cybul the recalled list being used by a second vendor different from the first, to present a customized selection of items in an on-line store or virtual storefront, because this will provide comparison information for a more informed decision.

### ***Response to Arguments***

Applicant's arguments filed 8/1/2008 have been fully considered but they are not persuasive.

In regards to claim 7, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In regards to claim 21 applicant argues that the combination of Cybul and Trotta do not teach that certain products of potential interest are not purchased by the shopper during the visit to the bricks and mortar store. It is noted that the store has many products that are on the shelf and of potential interest to the shopper but are not selected by the user. It is further noted that applicant is not claiming that the collected data of products of interest are not purchased by said shopper during said visit to the

store, but only that items of potential interest (all items on the shelf that might be of potential interest) are not selected and clearly Trotta teaches that only some of the many products of potential interest are selected during the visit to the store. Trotta further teaches deleting items from a list (col 4, lines 25-30).

In regards to claim 26, applicant's requests evidentiary documentation in support to the taking of official notice of the feature "...signing-on to an online store or virtual storefront over the internet, from a users computer". In support the examiner provides Bodnar, FIG 5B item 535.

Further in regards to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's arguments with respect to claim 31 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

Alexandria, Va. 22313-1450

or faxed to:

**571-273-8300**

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For general questions the receptionist can be reached at

571.272.3600

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/Mark Fadok/  
Primary Examiner, Art Unit 3625